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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,984	12/05/2000	Yisroel Lefkowitz	5016-2	8696

7590

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EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/729,984

Applicant(s)

LEFKOWITZ, YISROEL

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-12,14-60 and 67-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-60 and 67-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to communication filed on 2/17/2006.
2. Claims 1-2, 4-12, 14-60 and 67-84 are presented for examination.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-2, 4-5, 7-12, 14, 15, 17-20, 67-79, 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa, patent number 5,732,398 in view of Business Wire "Air France Corrects and Replaces Previous Announcement", 1/23/96.**

Tagawa teaches a method of selling international tickets in combination with duty free items comprising: offering at least one specific international ticket at a price below a then current price (col. 3, lines 25-35, col. 15, lines 55-60), acknowledging the purchase decision and accepting payment (col. 17, lines 25-35), delivering the ticket to the customer (col. 16, lines 10-25), advising the customer of the method of delivery of the duty free item (col. 18, lines 35-40). Tagawa also teaches offering one or more of a plurality of tickets to a variety of destinations (col. 6, lines 6-15), offering one or more of a plurality of duty free items (col. 18, lines 20-22) where the duty free items have differing assigned values as in a catalog, selecting at least one ticket from among a plurality of tickets and selecting at least one duty free item from among the plurality of items (col. 10, lines 60-65, col. 12, lines 30-45, col. 15, lines 25-50, col. 16, lines 40-50,

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col. 18, lines 25-35),. Viewing itinerary and pricing information by accessing a web site over a computer network (col. 9, lines 63-65, col. 18, lines 47-60), viewing descriptive information concerning the duty free items by accessing a web site over a network (col. 9, 63-65, col. 18, lines 23-30),.making payment for the ticket by providing credit card information (col. 17, lines 25-35, col. 9, lines 18-20),. customer providing an address over the computer network (col. 18, lines 18, lines 35-40). Tagawa does not offer the ticket or the duty free item for at no additional cost with the purchase of the item or the ticket.

With respect to offering the duty free item at no additional cost. Air France teaches offering **free gifts and vouchers for duty free items** so therefore in the system of Air France it would have been obvious for the free gift to have been for the duty free items in order to motivate the customers to conduct business with the company.

With respect to the newly added feature of the offer being made over a computer network from a single source. In the Kiosk of Tagawa, the users can purchase the travel tickets along with the duty-free items from main source which is the kiosk (see Figure 3).

With respect to the newly amended feature of offering a first type of product as an incentive to purchase a second type of product wherein the value of the first type of product varies as a function of the price of the second type of product. The Examiner wants to point out that since the combination of Tagawa and Air France teaches offering **free gifts/vouchers for duty free items for the purchase of airline tickets** and

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the Examiner is taking official notice that it is old and well known that increasing the amount purchase will result in a bigger discount of a second item. For example, JC Penney and the like will provide a \$10.00 discount on purchases of \$50.00, and \$20.00 discount on purchases of \$75.00 and \$25.00 discount on purchases of \$100.00 or more therefore motivating the purchaser to increase the purchase amount in order to receive a larger incentive or discount on a second product. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have combined the teachings of Tagawa and Air France to include increasing the amount of a discount by a function of amount value of a product purchased because such a modification would provide the above mentioned advantage.

**4. Claims 6, 16, 28, 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa in view of Business Wire "Air France Corrects and Replaces Previous Announcement" 1/23/96 further in view of Ong-Yeoh "Golden Boutique Set to Boost MAS Revenue", Business Times (Malaysia), 8/26/95.**

Ong-Yeoh teaches advising the customer that the duty free items will be delivered to the customer at one of an international port of departure ("pre-order business where passengers can purchase their tickets and duty free items to be delivered at the airport). It would have been obvious to one having ordinary skill in the art at the time of the invention to have advised the customer of item delivery as in Ong-Yeoh in the system of Tagawa since the item delivery would have been adopted for the intended use of the pre-order business of Tagawa at least where the ticket and item inspection verifies eligibility of the duty free item.

**Response to Arguments**

5. Applicant argues that the references do not teach the value of the product offered as incentive being determined as a function of the value of the item purchased but this is not relevant to the use of Official Notice. While applicant may challenge the Examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where *In re Boon* is mentioned

6. Applicant argues that Tagawa doesn't teach that one merchant who offers goods for sale through the kiosk is compelled to provide free ( or discounted) goods from another type or group of merchants. The Examiner disagree with Applicant because on col. 4, lines 28-31 Tagawa states "**the method further comprises closing a sale, accepting payment for the flight or flights selected by the user and a delivering a non-Airline-Reporting Corporation value voucher for the paid flight or flights to the user**" Applicant cited col. 19, lines 5-17 of Tagawa as teaching a preferred embodiment wherein the contracts are made directly with the airlines to issue value vouchers. Applicant is reminded that AReference disclosure must be evaluated for **all** that it fairly **suggests** and not only for what is indicated as preferred.≡ *In re Bozek*, 163 USPQ 545 (CCPA 1969). Applicant is only relying on a preferred embodiments and ignoring other fair teachings and embodiments.

7. Applicant states that the Business Wire Article does not describe the provision of a specific duty free item, just a voucher and that a voucher is different from a duty free item. The Examiner wants to point out that the Business Wire Article does not

only disclose vouchers but also discloses free **gifts**. In addition, the claims does not exclude the use of vouchers to obtain the duty free items.

8. Applicant argues that The Business Wire Article does not teach that the value of the duty free item (or even the voucher) will vary as a function of the cost of the ticket. Applicant is again reminded that Applicant's arguments are not relevant to the use of Official Notice. While applicant may challenge the Examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon is mentioned

9. With respect to the evidence of secondary consideration, it states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Raquel Alvarez  
Primary Examiner  
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